REMARKS

Claims 2 and 4 are currently pending in the application. In the Office Action, the Examiner has rejected independent Claims 2 and 4 under 35 U.S.C. § 103(a) as being unpatentable over Admitted Prior Art (APA), in view of Barkat et al. (U.S. 5,805,672) and in view of Kawashima (U.S. 5,201,068).

Independent Claims 2 and 4 were rejected as being unpatentable over APA in view of Barkat and in view of Kawashima. More specifically, the Examiner asserts that APA discloses all the elements of these claims, except for registering the voice command by the user, which is allegedly taught in Barkat, and the voice command for commanding the volume adjustment of the cellular phone, which is allegedly taught by Kawashima.

The APA discloses that key tone volumes can be adjusted through the manipulation of buttons on the cellular phone. Although Barkat discloses voice recognition to dial certain phone numbers, Barkat does not teach or disclose any functions associated with key tones. And, although Kawashima discloses controlling an output voice volume via voice recognition, Kawashima also does not teach or disclose any functions associated with key tones. Therefore the only teaching of using voice commands to control the volume of key tones is disclosed by the present application.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Kotzab,* 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee,* 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002). M.P.E.P. 2143.01.

The mere fact that references <u>can</u> be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re*

Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). M.P.E.P. 2143.01.

A statement that modifications of the prior art to meet the claimed invention would have been "'well within the ordinary skill of the art at the time the claimed invention was made'" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab,* 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). M.P.E.P. 2143.01. Applicants may argue that the Examiner's conclusion of obviousness is based on improper hindsight reasoning. Any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure..." *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). M.P.E.P. 2145.

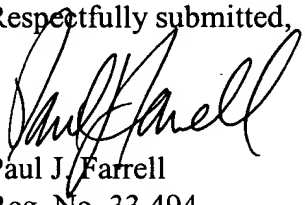
Since the conclusion of obviousness and the reason for confirming could be gleamed only from Applicant's disclosure, the rejection is improper.

Based on at least the foregoing, withdrawal of the rejection of Claims 2 and 4 is respectfully requested.

Independent Claims 2 and 4 are believed to be in condition for allowance.

Accordingly, all of the claims pending in the Application, namely, Claims 2 and 4, are believed to be in condition for allowance. Should the Examiner believe that a telephone conference or personal interview would facilitate resolution of any remaining matters, the Examiner may contact Applicant's attorney at the number given below.

Respectfully submitted,



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